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REMARKS/ARGUMENTS

Claims 1 to 28 are pending in the application. Claims 1 to 28 have been rejected. Reconsideration of the claims is requested.

Claims 18 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bonilla et al. (6,114,623). This rejection is respectfully traversed. Claim 18 has been amended to clarify that each of four separately formed simplex power receptacles comprises a respective housing, a feature that is neither disclosed or suggested by Bonilla et al.¹ Rather, as was explained in the prior amendment, Bonilla et al. discloses a poke-through fitting wherein a single housing (receptacle 34) presents four power outlets 18. The power outlets 18 of Bonilla clearly are not "separately formed simplex power receptacles" because they all share a common housing and also share common bus bar elements as shown in Figures 1 and 4. Hence, claims 18 and 20 are patentable over Bonilla. Further, these claims are patentable over Whitehead (6,417,446) for the reasons given below. In particular, Whitehead does not disclose, suggest or make obvious the use of four separately formed simple power receptacles, as recited in claim 1.

Claims 1-2, 4-7, 9-11, 13-14, 16-17, 21-22 and 24-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Whitehead. This rejection is respectfully traversed.

¹ It is noted that no further searching is necessitated by this clarifying amendment to claim 18, since similar amendments were made to the other independent claims in the prior amendment. Hence, the amendment is proper at this time and should be entered.

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In order for a *prima facie* case of obviousness to be established, Section 2142 of the MPEP states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest *all* the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art.

Additionally, if a *prima facie* case of obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness. See MPEP Section 2142 ("The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."). The Applicants respectfully submit that there is no suggestion or motivation to modify Whitehead in the manner suggested in the Office Action, and, as such, a *prima facie* case of obviousness has not been established with respect to the rejection of the pending claims of the present application in view of Whitehead.

As is acknowledged in the Office Action, Whitehead fails to disclose a poke-through fitting comprising four separately formed simplex power receptacles . . . each simplex power receptacle having a separate housing." Rather, according to the Office Action:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Whitehead with each of said simplex power

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receptacle having a respective housing, since it has been held that forming in one piece an article which has previously been formed in two pieces and to put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

However, the cited proposition from the *Howard* case does not support the Examiner's contention that it would be obvious to form the two duplex receptacles 98, 99 disclosed in Whitehead as four separate simplex power receptacles, each having a respective housing. Rather, *Howard* deals with the opposite situation, i.e., of combining two separate components into a single component. Further, it should be noted that this proposition from *Howard* "must be limited to cases where by such a change no new or different result is attained." *Pyle Nat. Co. et al. V Lewin*, 92 F.2d 628, 630 (7th Cir. 1937). In this regard, the utilization of four separate, simplex power receptacles, as recited in claim 1, facilitates more flexibility in the configuration of the poke-through fitting, for example in comparison to a fitting that uses two duplex power receptacles, such as those disclosed in Whitehead.

The Office Action further states that Whitehead discloses that the device may be modified to provide only a single receptacle, e.g., receptacle 99, citing to column 8, line 2. However, the "single receptacle 99" of Whitehead is still a duplex receptacle with two outlets. There simple is no suggestion in Whitehead to provide four simplex receptacles, each having a respective housing. Rather, the cited passage of Whitehead is directed to the alternate configuration shown in Figure 6, in which a poke through device 10' has a single (duplex) power receptacle 99 and four data jacks. This is to be contrasted with the embodiment of Figures 1 and 5 of Whitehead, which provides two

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duplex receptacles 98, 99 and two data jacks 130. Specifically, in the embodiment of Figure 6, one of the duplex receptacles 98 is eliminated and replaced with two additional data jacks.

Finally, the Office Action notes that at column 9, lines 7-13 Whitehead states "that those skilled in the art will realize that various changes and modifications may be made to the invention without departing from the invention." As stated above, a prima facie case of obviousness requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Further, as stated in Section 2143 of the MPEP,

The teaching or suggestion to make the claimed combination and the reasonable expectation of success *must both be found in the prior art, not in the applicant's disclosure.*

The boilerplate language contained at column 9, lines 7-13 of Whitehead does not teach or suggest that the duplex receptacles 98, 99 of Whitehead could or should be formed as four simplex receptacles, each having a respective housing. Instead, it appears that impermissible hindsight is being used to recreate the claimed inventions.

The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

See MPEP at Section 2142.

While the Applicants understand that the use of hindsight may be difficult to avoid, it must, nevertheless, actually be avoided.

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It is difficult but necessary that the decisionmaker forget what he or she has been taught... about the claimed invention and cast the mind back to the time the invention was made... to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.

See MPEP 2141.01 (III) at page 2100-117 (citation omitted). The Applicants respectfully submit that there is no teaching, nor suggestion, in Whitehead to provide four separately formed simplex power receptacles each simplex power receptacle having a separate housing. Thus, the Applicants respectfully submit that the Examiner is using impermissible hindsight to modify Whitehead and, as such, a *prima facie* case of obviousness has not been established with respect to the rejection of the pending claims of the present application. In view of the above, claim 1, and its dependent claims 2 and 4-5, are patentable over Whitehead.

Similarly, Independent claim 6 is patentable over Whitehead because Whitehead fails to disclose or suggest a poke-through fitting comprising "four separately formed simplex power receptacles, each simplex power receptacle having a respective housing." Nor, as noted above would it be obvious to form the duplex receptacles 98, 99 of Whitehead as four separate simplex receptacles. Further, Whitehead fails to disclose or suggest a poke-through fitting having both "four separately formed simplex power receptacles" and "four communication/data jacks," as recited in claim 6. Rather, Whitehead discloses three alternative configurations. (See, e.g., Whitehead, Abstract). The first Whitehead configuration, which can best be seen in Figures 1 and 5, includes two duplex power receptacles 98, 99 (presenting four total power outlets) and two data

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Jacks 130. An first alternative configuration (See Fig. 6) provides a single duplex power receptacle 90 and four data jacks 130. In this second embodiment, the duplex power receptacle 98 of the first embodiment is replaced by two additional data jacks. As is explained in Whitehead:

Device 10' utilizes platform 116 of device 10, but utilizes a mounting plate '128' rather than mounting plate 128. As shown, mounting plate 128' includes a wing 162 which allows the mounting of two additional category 5 data jacks in the region formerly occupied by receptacle 98 (see also FIG. 9). (*Whitehead*, at col. 8, lines 6-11).

Whitehead also describes a third embodiment having six data jacks and no power receptacles. (See Figure 10 and col. 8, lines 31-38). However, Whitehead does not disclose or suggest a poke-through fitting that include both four simplex power receptacles and four data jacks. Nor would it be obvious to so modify Whitehead given the space constraints imposed on poke through fittings. Specifically, as noted in Whitehead, building codes typically restrict such fittings to a maximum diameter of four inches.

Inasmuch as floor structure 14 is typically a structural, load bearing member of the building, the maximum size of the interfloors is limited by building code requirements. In particular, interfloors holes, typically range in diameter from two to four inches. In one preferred embodiment, hole 12 is formed with a four inch diameter. (*Whitehead* at col. 4, line 65 to col. 5, line 3).

Hence, claim 6 and its dependent claims are believed to be patentable over Whitehead.

Claims 11 and 13 are similarly patentable over Whitehead for the reasons given above in connection with independent claims 1 and 6. Namely, Whitehead does not

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disclose or suggest the a poke-through wiring fitting having "four separately formed simplex power receptacles, each power receptacle having a respective housing mounted within the fitting." Nor, as discussed above, would it be obvious to construct the duplex receptacles 98, 99 of Whitehead as four simplex power receptacles. Further, as discussed in connection with claim 6, Whitehead does not contemplate, disclose or suggest a poke-through fitting having both four simplex power receptacles and four communication/data jacks mounted within the fitting. Hence, claims 11 and 13 are patentable over Whitehead.

Claim 14 is patentable over Whitehead for the reasons given above in connection with claim 1. Namely, Whitehead does not disclose or suggest the a poke-through wiring fitting having "four simplex power receptacles, each power receptacle having a respective housing." Nor, as discussed above, would it be obvious to construct the duplex receptacles 98, 99 of Whitehead as simplex power receptacles. Hence, claim 14 is patentable over Whitehead.

Likewise, claim 16 is patentable over Whitehead because Whitehead does not disclose or suggest the a poke-through wiring fitting having four simplex power receptacles, each of which has a respective housing. Nor, as discussed above, would it be obvious to construct the duplex receptacles 98, 99 of Whitehead as four simplex power receptacles. Further, as discussed in connection with claim 6, Whitehead does not contemplate, disclose or suggest a poke-through fitting having both four simplex power receptacles and four communication/data jacks mounted within the fitting. Hence, claims 16 is patentable over Whitehead.

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'Method claims 21-22 and 24-28 are also patentable over Whitehead for the reasons given above. Specifically, Whitehead does not disclose or suggest mounting four simplex power receptacles within the insert (or fitting), wherein each simplex power receptacle has a respective housing. Nor, as discussed above, would it be obvious to construct the duplex receptacles 98, 99 of Whitehead as four simplex power receptacles. Hence claims 21-22 and 24-28 are patentable over Whitehead.

Claims 3, 8, 12, 15 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Whitehead in view of Bonilla et al. According the Office Action. Whitehead fails to disclose fire stopping material within the insert. In this regard, it is noted that Whitehead actually does disclose the use of intumescent material. (See col. 5, lines 17-30 and col. 8, lines 39-52). Regardless, these claims are patentable over the proposed combination of Bonilla and Whitehead, neither of which disclose, suggest or contemplate a poke-through fitting with four simplex power receptacles, where each simplex power receptacle has a respective housing. Rather, as discussed above, Whitehead and Bonilla et al. both describe fittings that utilize duplex power receptacles and it would not be obvious to replace the duplex receptacles of Whitehead or Bonilla et al. with four separate simplex receptacles. Hence, claims 3, 8, 12, 15 and 23 are patentable over Whitehead in view of Bonilla et al.

Claim 19 stands rejected as being unpatentable under 35 U.S.C. 103(a) over Bonilla et al. Claim 19 depends from claim 18 and is patentable over Bonilla et al. for the reasons given above.

FROM McANDREWS, HELD, & MALLOY

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In view of the above, claims 1 to 28 are believed to be in condition for allowance. The Examiner is invited to telephone the applicants' undersigned attorney at (312) 775-8000 if any unresolved matters remain.

Fee Payment and Authorization

Please charge any fees due in connection with this submission to Deposit Account No. 13-0017.

Respectfully submitted,



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